

## **REMARKS**

### **I. AMENDMENTS TO THE SPECIFICATION**

The specification is amended herein to include the recitations of original claims 23-25, and 27-43 that were filed with the application (*see* pages 296-299 of the application). No new matter has been added with this amendment.

### **II. CLAIM AMENDMENTS**

Claims 49 to 165 were pending in the application. Claims 53, 54, 56-59, 64-65, 74, 75, 77, 78 and 85-87 have been canceled without prejudice. Claims 67, 69, 70, 79, 81-83 and 89-165, drawn to non elected subject matter, are canceled without prejudice to Applicants' right to pursue the subject matter of these canceled claims in related patent applications. Claims 49, 50-52, 55, 60-63, 66, 68, 71-73, 76, 80, 84 and 88 have been amended and claim 166-216 have been added to clarify the invention. The amendments have not been made over prior art. No new matter has been added. Upon entry of the above-made amendments, claims 49, 50-52, 55, 60-63, 66, 68, 71-73, 76, 80, 84, 88 and 166-216 will be pending.

Support for the claim amendments and new claims is found in the originally-filed specification, as indicated in the table below.

Claims	Examples of support in the specification
Claims 49 and 182	"light scattering particles comprising gold" p. 20, ll. 15 - p. 21, ll. 6; p. 78, ll. 19 - p. 81, ll. 32; p. 83, ll. 11 - p. 85, ll. 20; Tables 14 and 15; "of a size between 1 and 500 nm" p. 26, ll. 2-5; color not distinguishable within a population - p. 85, ll. 24 - p. 87, ll. 30.
Claim 50	p. 28, ll. 1-12
Claims 61-63, 66, 68, 71-73, 80 and 84	p. 20, ll. 15 - p. 21, ll. 6; p. 78, ll. 19 - p. 81, ll. 32; p. 83, ll. 11 - p. 85, ll. 20; Tables 14 and 15; p. 26, ll. 2-5;
Claims 166-172, 176-179, 184-190, 194, 195, 197, 198, 201 and 202.	p. 83, ll. 11-31; p. 177, ll. 30 - p. 178, ll. 2; p. 184, ll. 10 - p. 192, ll. 26; p. 236, ll. 6 - p. 237, ll. 26.
Claims 173, 175, 183, 191, 180, 194, 195, 197, 198, 201 and 202	p. 62, ll. 20-p. 63, ll. 28; Tables 3, 4, 5, 10 and 15; p. 83, ll. 32 - p. 84, ll. 11.
Claims 174, 178, 179, 181, 199 and 200	Tables 13 and 15

Claims 80, 84, 213 and 214	Tables 13 and 14; p. 258, ll. 1-31.
Claims 180, 181, 203 and 204	p. 203, ll. 21 - p. 204, ll. 3.
Claims 88 and 182	p. 85, ll. 24 - p. 87, ll. 30.
Claims 175, 192 and 193	Table 14
Claims 76, 80, 212, 213 and 214	pp. 296-299, originally filed claims 23 and 39-43.
Claims 196 and 215	p. 45, ll. 19 - p. 46, ll. 28
Claims 55, 205-208	p. 20, ll. 15 - p. 21, ll. 6; p. 22, ll. 27 - p. 23, ll. 15
Claims 209 and 210	p. 83, ll. 11 - p. 85, ll. 20.
Claim 216	p. 256, ll. 30 - p. p. 257, ll. 17; p. 258, ll. 1 - 31; p. 269, ll. 1 - 33.

### **III. RESTRICTION REQUIREMENT**

The Examiner has required a restriction under 35 U.S.C. § 121 of one of the following inventions:

- I. Claims 49-61, 63-66, 68, 71-78, 85-88, drawn to a population comprising gold particles, classified in class 520, subclass 507.
- II. Claims 49-60, 62, 63, 67, 69, 70, 72-75, 80-88, drawn to a population comprising silver particles, classified in class 520, subclass 501.
- III. Claims 89-94, 95, 97-107, 112-114, 116-119 drawn to a specifically detectable light scattering gold particle reagent, classified in class 520, subclass 503.
- IV. Claims 89-94, 96, 97-106, 108, 110-115, 120-124, drawn to a specifically detectable light scattering silver particle reagent, classified in class 520, subclass 505.
- V. Claims 125-126, drawn to a multiparticle optical signal agent, classified in class 520, subclass 35.
- VI. Claims 127-134, drawn to a method for making specifically detectable gold particles, classified in class 23, subclass 300.
- VII. Claims 135-142, drawn to a method for making specifically detectable coated silver particles, classified in class 23, subclass 301.
- VIII. Claims 143-145, 151-158, drawn to a test kit comprising a plurality of nucleic acid molecules, classified in class 435, subclass 6.
- IX. Claims 143, 144, 146, 148, 149, 151-158, drawn to a test kit comprising a plurality of antibodies, classified in class 435, subclass 7.1.
- X. Claims 143, 144, 147, 151-158, drawn to a plurality of receptors, classified in class 435, subclass 7.8.

- XI. Claims 143, 144, 150-158, drawn to a plurality of pharmaceutical agents, classified in class 436, subclass 506.
- XII. Claims 159-165, drawn to a test kit comprising a plurality of populations of different distinguishable metal light scattering particle types, classified in class 423, subclass 21.1.

The Examiner contends that the inventions are distinct, each from the other.

In order to be fully responsive, Applicants hereby provisionally elect the invention of Group I, claims 49-61, 63-66, 68, 71-78, 85-88, drawn to a population of particles comprising gold, classified in class 520, subclass 507, with traversal. Applicants submit that amended claims 62, 80 and 84, and new claims 166-216, fall within the elected group of the invention of Group I.

With respect to Examiner's division of the invention into twelve groups and the reasons stated therefor, Applicants respectfully traverse. The groups of claims specified by the Examiner are not distinct inventions but rather an intricate web of knowledge and continuity of effort which merit examination of all claims in a single application.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. §1.144.

Applicants respectfully request that the amendments and remarks made herein be entered and made of record in the file history of the instant application.

Respectfully submitted,

Date: April 5, 2004

Laura A. Coruzzi 30,742  
Laura A. Coruzzi (Reg. No.)

By: T. Christopher Tsang 40,258  
T. Christopher Tsang (Reg. No.)

**JONES DAY**  
222 East 41st Street  
New York, New York 10017-6702  
(212) 790-9090

Enclosure